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November 9, 2001

VIA CERTIFIED MAIL: Restricted Delivery

Dr. David A. Stenger
CODE 6910
Naval Research Laboratory
Washington, D.C. 20375

Re: U.S. Patent Application for
BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND
PHARMACOLOGICAL SCREENING
Serial Nos.: 09/880,138 and 09/928,708
Inventors: James J. Hickman, Douglas G. Kirkpatrick
and David A. Stenger
Our Ref. No. 18805-81106 and 18805-81052

Dear Dr. Stenger:

It was a pleasure speaking with you regarding the above-identified patent application. As I mentioned during our telephone conference, I am one of the attorneys for Science Applications International Corporation ("SAIC") responsible for prosecuting the above-identified patent application.

During our telephone conference, you asked that we provide you with a copy of the application, after which you would make a determination as to whether you would execute the paperwork necessary to facilitate the prosecution of this application. Accordingly, we are enclosing a copy of the application, the Declaration, and the Assignment for your review.

Because of time constraints, we filed the application without an inventor(s)' Declaration and Assignment, (part of what is collectively known as "formal papers").

As we anticipate the *Notice of Missing Parts* from the United States Patent and Trademark Office ("USPTO"), we will need to file formal papers by no later than **November 20, 2001**. Therefore, we have prepared and enclose a copy of the application as filed, along with an original and one copy of an Inventor Declaration for each inventor's signatures. Of course, you will be signing on behalf of yourself. You will notice that there are two iterations of the

Dr. David A. Stenger
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Inventor(s) Declaration concerning this application. This is a result of the fact that this case has been pending for some time and the fact that the USPTO is processing the application in duplicate, giving rise to two application numbers assigned to the identical invention. As you can see, aside from the different application numbers, the two pending "Biosensor" applications are identical in all respects. At some point, the USPTO will elect to proceed with only one of them. Until that time, we have no choice but to prosecute both. If you have any questions regarding this matter, please do not hesitate to call me.

Although we have not independently confirmed your inventorship, we are operating under this understanding, in light of the fact that your name appears on the original application as one of the inventors. If you do not believe that you are one of the inventors, then please indicate to us as much in writing.

Please review the application for accuracy and completeness. It is essential to ensure that the application completely describes the best mode each inventor knows for carrying out the invention and to ensure that it is sufficiently detailed to teach one of ordinary skill in the art to make and use the invention. Also, you should read the claims carefully to ensure that they cover all known alternative embodiments of the invention and are not otherwise unduly limiting.

Please keep in mind that the Declaration contains an acknowledgment of the duty as an inventor to disclose all information of which each is aware that is material to examination of the application. This is a continuing duty which does not terminate upon filing of the application.

If it is believed that any changes are necessary in the disclosure or the claims, please let me know. For these changes, it may be possible to file a preliminary amendment before a first office action by the USPTO.

Once you have reviewed the application and confirmed that it complies with the foregoing, please refer to page 3 of each Declaration, fill in your complete residence address (a USPTO requirement), verify your citizenship, then sign and date the Declaration. If any of the information provided must be corrected, then please white-out the incorrect information and type-in the correct information.

Also enclosed is an original and one copy of an Assignment of the invention. Please complete your residence address on the first page of the original Assignment, sign and date as indicated using the same date as the patent Declaration and have your signature notarized. Please return the executed originals of the Declaration and notarized Assignment to us in the pre-paid, self-addressed FedEx envelope enclosed for your convenience.

As I am sure you can appreciate, the application is highly confidential and neither it nor the information embodied therein may be disclosed to third parties.

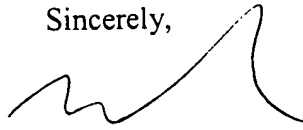
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We look forward to your prompt response as we are operating on a short deadline in which to file these papers with the USPTO.

In addition, as we have to date been unable to locate Dr. Douglas Kirkpatrick's whereabouts, we would appreciate your providing us with contact information for him, if you know. He also is required to execute these materials.

We thank you in advance for your anticipated cooperation in this matter.

Sincerely,

A handwritten signature in black ink, appearing to read 'Mark B. Mizrahi', with a stylized, flowing script.

Mark B. Mizrahi

MBM:shd

Enclosures:

- Copy of the applications, with Preliminary Amendment
- Original and one copy of Declarations
- Original and one copy of Assignment
- Pre-paid, self-addressed FedEx envelope

APPLICATION
for
UNITED STATES LETTERS PATENT
on

**BIOSENSOR FOR USE IN TOXICITY ASSESSMENT
AND PHARMACOLOGICAL SCREENING**

by

JAMES J. HICKMAN, DOUGLAS G. KIRKPATRICK, AND DAVID A. STENGER

18810-81106

Sheets of Drawings: 5

Attorneys
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I HEREBY CERTIFY THAT THIS PAPER OR FEE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE
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(PRINTED NAME OF PERSON MAILING PAPER OR FEE AND SIGNATURE)

Docket No.
18805-81106



Declaration For Patent Application

English Language Declaration

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND PHARMACOLOGICAL SCREENING

the specification of which

(check one)

☐ is attached hereto.

☒ was filed on JUNE 12, 2001 as United States Application No. or PCT International

Application Number 09/880,138

and was amended on n/a

(if applicable)

RECEIVED
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OFFICE OF PETITIONS

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or Section 365(b) of any foreign application(s) for patent or inventor's certificate, or Section 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate or PCT International application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Priority Not Claimed

n/a

n/a

n/a

☐

(Number)

(Country)

(Day/Month/Year Filed)

☐

(Number)

(Country)

(Day/Month/Year Filed)

☐

(Number)

(Country)

(Day/Month/Year Filed)

I hereby claim the benefit under 35 U.S.C. Section 119(e) of any United States provisional application(s) listed below:

| n/a | n/a |
|--------------------------|---------------|
| (Application Serial No.) | (Filing Date) |
| (Application Serial No.) | (Filing Date) |
| (Application Serial No.) | (Filing Date) |

I hereby claim the benefit under 35 U. S. C. Section 120 of any United States application(s), or Section 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. Section 112, I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, CFR Section 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application:

| SEE EXHIBIT A | | |
|--------------------------|---------------|--|
| (Application Serial No.) | (Filing Date) | (Status) (patented, pending, abandoned) |
| (Application Serial No.) | (Filing Date) | (Status) (patented, pending, abandoned) |
| (Application Serial No.) | (Filing Date) | (Status) (patented, pending, abandoned) |

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

| | |
|---|------|
| Full name of sole or first inventor JAMES J. HICKMAN | |
| Sole or first inventor's signature | Date |
| Residence 125 GRAND OAKS CIRCLE, PENDLETON, SC, 29670 | |
| Citizenship U.S.A. | |
| Post Office Address Same as above | |
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|---|------|
| Full name of second inventor, if any DOUGLAS A. KIRKPATRICK | |
| Second inventor's signature | Date |
| Residence 10929 BEACH MILL ROAD, GREAT FALLS, VA, 22066 | |
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| | |
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| Full name of third inventor, if any DAVID A. STENGER | |
| Third inventor's signature | Date |
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| Citizenship U.S.A. | |
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| Fourth inventor's signature | Date |
| Residence | |
| Citizenship | |
| Post Office Address | |
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|-------------------------------------|------|
| Full name of fifth inventor, if any | |
| Fifth inventor's signature | Date |
| Residence | |
| Citizenship | |
| Post Office Address | |
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|-------------------------------------|------|
| Full name of sixth inventor, if any | |
| Sixth inventor's signature | Date |
| Residence | |
| Citizenship | |
| Post Office Address | |
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|---------------------------------------|------|
| Full name of seventh inventor, if any | |
| Seventh inventor's signature | Date |
| Residence | |
| Citizenship | |
| Post Office Address | |
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|----------------------------------|------|
| Full name of eighth inventor, if | |
| Eighth inventor's signature | Date |
| Residence | |
| Citizenship | |
| Post Office Address | |
| | |

EXHIBIT A

Patent application Serial No. 09/880,138, filed on June 12, 2001, was filed in connection with Applicant's Petition to Revive filed on that same date. If the petition is granted, the 09/880,138 application will be accepted as a continuation of Serial No. 09/513,720, filed on February 24, 2000, and which unintentionally went abandoned on June 12, 2000. In the event that the Petition is not granted, the 09/880,138 application will be deemed related to the 09/513,720, rather than a continuation thereof.

The 09/513,720 application was itself a continuation of application Serial No. 09/372,568 filed on August 11, 1999, the prosecution of which was abandoned in favor of the 09/513,720 application.

Patent application Serial No. 09/372,568, in turn, was a continuation of application Serial No. 09/236,684, filed on January 25, 1999, the prosecution of which was abandoned in favor of the 09/372,568 application.

Patent application Serial No. 09/236,684, in turn, was a continuation of application Serial No. 09/109,481, filed on July 2, 1998, the prosecution of which was abandoned in favor of the 09/236,684 application.

Patent application Serial No. 09/109,481, in turn, was a continuation of application Serial No. 08/912,033, a non-provisional utility application, filed on August 15, 1997, the prosecution of which was abandoned in favor of the 09/109,481 application.

Patent application Serial No. 08/912,033, in turn, claims the benefit of provisional application Serial No. 60/023,413, filed on August 16, 1996.